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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shane Williams, dba Public Safety Publications

Serial No. 75/942,409

Eugene J. Rath III of Price, Heneveld, Cooper, DeWitt & Litton for Shane Williams, dba Public Safety Publications.

Brian A. Rupp, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Shane Williams, dba Public Safety Publications (applicant) has appealed from the final refusal of the Trademark Examining Attorney to register the mark FIRE TRADER for "buying, selling, trading and advertising of new and used fire safety and fire safety-related products and services via a computerized global network and via printed

publication."¹ Applicant and Examining Attorney have submitted briefs but no oral argument was requested.

There are two issues in this appeal--mere descriptiveness under Section 2(e)(1) of the Act and the sufficiency of applicant's description of services.

Mere Descriptiveness

Based upon dictionary definitions and excerpts from applicant's specimens and Web site, the Examining Attorney argues that the mark FIRE TRADER is merely descriptive of applicant's services.² While in his first Office Action the Examining Attorney argued that "FIRE" refers to "flammable items," in a subsequent refusal and his brief he argued that "FIRE" in applicant's mark refers to applicant's fire safety-related goods and services. Coupled with the word "TRADER," which the Examining Attorney contends is a common term used to describe activities of those involved in buying, selling and trading, the word FIRE in applicant's mark describes a purpose, characteristic, function, feature or use of applicant's services--that of trading fire-related items or trading "fire materials." The Examining

¹Application Serial No. 75/942,409, filed March 13, 2000, based upon allegations of use since June 1, 1998. Pursuant to request, applicant submitted a disclaimer of the word "TRADER."

²The American Heritage Dictionary of the English Language Third Edition (1992) defines "fire" as, among other things, "A rapid, persistent chemical change that releases heat and light and is accompanied by flame...", and "trader" as "One that trades; a dealer: a *gold trader*; a *trader in bonds*."

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Attorney contends that no imagination is required to understand the nature of applicant's services--that applicant is a trader "in all things related to fire."

In his brief, the Examining Attorney refers to the following excerpts from applicant's specimens as well as applicant's Web site:

"Fire Trader specializes in new and used fire apparatus, and equipment."

"FIRE TRADER has 'one of the Largest Selections of Fire...related Books and Equipment on the Web!'"

"FIRE TRADER provides information from thousands of paid Fire Departments."

"FIRE TRADER buys equipment from fire departments."

"FIRE TRADER offers firefighting equipment, firefighter badges, and firefighting books and videos."

In conclusion, the Examining Attorney argues that, like the term "Fire Insurer" used to describe an underwriter of fire insurance policies, the asserted mark FIRE TRADER is a combination of two descriptive words immediately describing the nature and purpose of applicant's services.

Applicant, on the other hand, maintains that his mark does not immediately convey information concerning his services and is, at most, only suggestive of them. Applicant contends that "FIRE" is not a significant

function or attribute of his goods or services. Contrary to the Examining Attorney's position, applicant argues that the word "FIRE" in his mark does not conjure up an image of equipment such as fire engines, fire suits, oxygen tanks, etc., but instead could refer to a number of different things such as campfires, fireplaces, blazing infernos, fireworks, fire-starting substances or other fire-related goods or services. Applicant does not trade fire, applicant maintains. Because a multi-stage reasoning process or degree of imagination is necessary to determine the nature of applicant's services, applicant argues that his mark is not merely descriptive. Finally, applicant states that competitors do not need to use these words in describing their services.

A mark is merely descriptive if it immediately describes the ingredients, qualities or characteristics of the goods or services, or if it conveys information regarding a function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). A term may be descriptive even if it only describes one of the qualities or properties of the goods or services. *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We must look at the mark in relation to the goods or services and the context

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in which it is used, and not in the abstract, when we consider whether the mark is merely descriptive. *Abcor*, 200 USPQ at 218.

A term which is suggestive, however, is registrable. A suggestive term is one that suggests, rather than describes, characteristics or attributes of a product, such that imagination, thought or perception is required to reach a conclusion about the nature of the goods or services. *In re Gyulay, supra*. There is often a fine line of distinction between a suggestive and a merely descriptive term, and it is sometimes difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. *In re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977). It is well settled, however, that where there is doubt on this issue, the doubt must be resolved in applicant's behalf and the mark should be published for opposition. See *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

Upon careful consideration of this record and the arguments of the attorneys, we agree with applicant that the combination of the words "FIRE" and "TRADER" creates a new non-descriptive mark with a separate and distinct commercial impression and meaning. Even when considered

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with respect to applicant's specific services, the mark FIRE TRADER requires some degree of imagination or thought in order to determine the nature of applicant's services. That is because the words in applicant's mark literally mean that applicant is trading "fire," which is not, of course, the case. Nor do we believe that this case is analogous to the clearly generic expression "fire insurer." Unlike that expression, there is simply no evidence that FIRE TRADER is or has been used by others. Furthermore, applicant's own use of the mark FIRE TRADER in his specimens and on his Web site appears to reflect proper service mark (or trade name) use. Finally, to the extent there is doubt on this issue, that doubt is resolved in favor of publication.

The Description of Services

In his final refusal, the Examining Attorney repeated a requirement that applicant submit an amended identification of services. He indicated that applicant's description of services is indefinite and that applicant must specify the common commercial name of the services, or the industry or field in which the services are used. The Examining Attorney suggested the following description, if accurate: "Computerized on-line retail services in the field of fire safety products; providing trade information

about fire services and fire safety products; dissemination of fire related advertising for others via an on-line electronic communications network."

In his appeal brief, the Examining Attorney stated that applicant's description is "indefinite because selling and sales are not services under the US Trademark Act or the Nice Agreement since the primary beneficiary of selling or sales is the seller. The Trademark Act requires an applicant to specify the services in an explicit manner, setting forth common names and using terminology which is generally understood... The recitation of services should be clear, accurate, and as concise as possible... The applicant has not complied with these requirements." In applicant's reply brief, applicant's attorney simply argued that the recitation of services is definite but that applicant would be willing to modify the description, if necessary, if the Examining Attorney's descriptiveness refusal is reversed.³

We believe that the current description of services-- buying, selling, trading and advertising of new and used fire safety and fire safety-related products and services via a computerized global network and via printed publication--is sufficiently clear and definite to inform

³ Applicant may not defer compliance with a requirement until after the Board's decision on the merits. All requirements not the subject of an appeal must be complied with prior to the filing of an appeal. See TBMP §§1201.02 and 1217.

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others of the specific nature of applicant's services. Further, the indication that applicant is buying, selling and trading fire-safety products and services makes it clear that these are not applicant's own products and services which are being bought, sold and traded under the mark FIRE TRADER. Accordingly, we find that the current identification is sufficiently definite and need not be amended.

Decision: The refusal to register under Section 2(e)(1) of the Act is reversed; the requirement with respect to applicant's description of services is also reversed.